

Remarks:

Applicants wish to thank the examiner for the express withdrawal of previous rejections of record.

The specification is amended, hereby, as required to overcome the objection set forth in the Office Action. Withdrawal of the objection is in order.

Claims 16-34, previously presented, are pending. Claims 1-15 were cancelled, without prejudice or disclaimer.

Claims 16-32 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,558,792 (Vaanbengaard) further in view of U.S. Publication No. 2005/0080155 (Fattman). Reconsideration is requested.

In the context of a rejection for obviousness under §103, the "Examiner bears [both] the initial burden . . . of presenting a *prima facie* case of unpatentability" and "the ultimate burden of persuasion on the issue." *In re Oetiker*, 24 USPQ 1443, 1444 and 1447 (Fed. Cir. 1992).

The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant references. . . . Indeed, the teachings of the references can be combined only if there is some suggestion or incentive to do so.

Ex parte Obukowicz, 27 USPQ2d 1063, 1065 (BPA&I 1992) (*emphasis added*).

The fact that all elements of a claimed invention are known does not, by itself, make the combination obvious. *Ex parte Clapp*, 227 USPQ 972 (BPA&I 1985). To support a rejection for

obviousness based on the combination of separate prior art teachings "even when the level of skill is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination." *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The mere fact that it is possible to find two isolated disclosures which might be combined in such a way as to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the *desirability* of the proposed combination.

In re Bergel, 130 USPQ 206, 208 (CCPA 1961) (*emphasis added*).

The presently claimed "adhesive composition" comprises (a) a block-copolymer and (b) a homopolymer; an embodiment being a polyisobutylene-styrene block copolymer (PIBS) and a polyisobutylene homopolymer (PIB). Vaanbengaard teaches the use of PIB combined with poly(styrene-isoprene-styrene) (SIS) in an adhesive composition and Fattman teaches the use of PIBS in a different adhesive composition. The rejection argues that it would have been obvious to use the PIBS of Fattman in place of the SIS of Vaanbengaard, and so combine PIB with PIBS, with the skilled artisan being (allegedly) motivated to do so in view of the Fattman teaching (¶[0058]) "that the migration resistance of the SIBS rubber formulations is superior to the control adhesive."

The rejection is based on an incorrect interpretation of Fattman: Fattman neither teaches nor suggests that the use of SIBS results in superior resistance to the migration of intestinal fluid, in comparison to the use of SIS (which is the alleged motivation for using SIBS, in place of SIS, in Vaanbengaard). The superior fluid-migration resistance described in ¶[0058] of Fattman (and relied on in the rejection) is based on comparing one SIBS containing composition with another SIBS

containing composition. In other words, the observed superiority had nothing whatsoever to do the fact that SIBS was used, but rather the result of different components combined with SIBS in the different formulations. This conclusion is consistent with Fattman's teachings (¶[0025]), "it has surprisingly been found that the chemical composition of the adhesive is a more significant factor" than "higher bond strength" with respect to "migration the intestinal fluid across the adhesively bonded interface." In fact, Fattman's invention encompasses SIS containing adhesives as well as SIBS containing adhesives. "[P]resumed knowledge does not grant a license to read into the prior art reference teachings that are not there." *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997).

Accordingly, at best, Fattman teaches no more than that both SIS containing adhesives and SIBS containing adhesives were known in the art which, by itself fails to show obviousness under §103(a). *Clapp, supra*. Vaanbengaard and Fattman are improperly combined to show obviousness under §103(a) "unless the art also contains something to suggest the *desirability* of the proposed combination. *Bergel*, 130 USPQ at 208 (*emphasis added*). "Lacking a motivation to combine [the cited] references" the §103(a) rejection is improper. *Rouffet*, 47 USPQ2d at 1458.

In view of the foregoing remarks, the rejection of claims 16-32 under §103(a), based on the teachings of Vaanbengaard in view of Fattman, is overcome. Withdrawal of the rejection is in order.

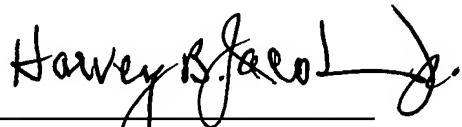
Claims 33 and 34 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Vaanbedgaard in view of Fattman, and further in view of U.S. Patent No. 5,109,874 (Bellingham). Reconsideration is requested.

The reliance on Vaanbedgaard in view of Fattman is misplaced, for the same reasons set forth above—with respect to the rejection of claims 16-32. Since present claims 33 and 34 are dependent, directly or indirectly, on present claim 16, the rejection of claims 33 and 34 under §103(a) cannot be maintained. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

In view of the foregoing remarks, the rejection of claims 33 and 34 under §103(a), based on the teachings of Vaanbengaard in view of Fattman, and further in view of Bellingham, is overcome. Withdrawal of the rejection is in order.

Favorable action is requested.

Respectfully submitted,



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